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09/381,508	09/21/99	METCALFE	1749-258

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EXAMINER
CAOTHULEN, N

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/381,508

Applicant(s)

METCALFE, PAUL DAVID

Examiner

Nam Caothulen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification is objected to because of the following informalities: there are no section headings for the field of the invention, back ground of invention, summary of invention, Brief description of the drawings and description of preferred embodiments. On page 11, line 10, reference numerals "68 and 69" refer to fingers of material, not tubing length, and on page 11, line 11 reference numeral "70" refer to fingers of material, not the sleeve.

Drawings

2. The drawings are objected to because the specification is referring to 70b in the drawing to indicate the fingers. However, examiner does not see 70b indicated anywhere in the figures provided. Appropriate correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the frangible links, as in claim 13, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. MPEP § 608.02(d).

Claim Rejections - 35 USC § 112

3. Claims 1,7-9,10,11-13,14 and 15 are rejected under 35 U.S.C.112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 14 "the

deformable fingers of the sleeve". Line 2 "overlapping" is inapt inasmuch as the slots don't appear to overlap anything. This is also found in line 12 where the spaced slots are said to "overlap".

As to claim 3, line 3, "the connection" lacks antecedent basis.

As to claim 7, line 15, "the endmost deformable fingers" lacks antecedent basis.

As to claim 8, line 3 and 4, "the end most deformable fingers" lacks antecedent basis.

As to claim 15, line 13, "the connection" lacks antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by (WO 98/22690) Lohbeck.

Lohbeck, discloses a method for coupling the ends of first and second lengths of expandable tubing and expandable the coupled tubing lengths, the method comprising the steps providing a sleeve defining overlapping longitudinal slots (Fig. 1 #4 (Col. 3, line 9-10)) and deformable fingers (Fig. 3 #17 (Col. 4, line 11-12)). It's also providing first and second lengths of expandable tubing (Fig. 1 #2and 3) defining overlapping longitudinal slots (Fig. 1 #4 (Col. 3, line 12-18)).

6. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by (US Patent No. 2,858,894) Akeyson.

Akeyson discloses a method of coupling providing a sleeve comprising longitudinally extending strips of material (Fig. 2 #2 (Col. 2, line 6-10).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Lohbeck (of record, International Publication No. WO 98/22690), in view of Campbell (US Patent No. 5,924,745).

As to claims 1-9, Lohbeck discloses an expandable tubing (Fig. 1 #2) having overlapping longitudinal slots (Fig. 1 #4) with nodes between the slots (Fig. 1, adjacent #2, indicates a node on the tubing), an intermediate portion (Fig. 1) where the first and second tubing lengths such that the expansion characteristics of the connected tubing are constant. The connector end portion and the nodes of the tubing end portions are threaded (Fig. 2 #11) to fasten the sleeve to each of the tubing lengths. However, Lohbeck fails to teach wherein each connector end portion defines an internal thread for engaging a corresponding thread on an outer surface of the respective tubing end

portion. Campbell teaches an expandable slotted tubing wherein each connector end portion defines an internal thread (Fig. 3 #33) for engaging a corresponding thread on an outer surface (Fig. 3 #32) for the purpose of securing the parts to one another. This prevents radial separation of the free ends of the parts when the connected tubing is expanded. Therefore, it would have been an obvious to one having ordinary skill in the art at the time the invention was made to modify Lohbeck as taught by Campbell to have an internal thread for engaging a corresponding thread on an outer surface for the purpose of a secure connection on expansion of the tubing lengths and the connector.

With respect to claim 6 Lohbeck discloses the claimed invention except for the connector end portions defining grooves to receive corresponding tongues provided on the tubing length end portion. Campbell teaches the connector end portions define groove (Fig. 3 #34,35) to receive corresponding tongues (Fig. 3 #36,37) for the purpose of preventing separation of the connection on expansion of the tubing. It would have been an obvious to one having ordinary skill in the art at the time the invention was made to modify Lohbeck's conforming grooves to receive corresponding tongues as taught by Campbell in order obtaining a secure seal in a expandable slotted tubing.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103 as being obvious over Lohbeck, and further in view of Akeyson (US Patent No. 2,858,894). Lohbeck discloses all of the claim subject matter as described above except for a sleeve of longitudinally extending strips of metal. Akeyson teaches a sleeve of longitudinally extending strips of metal (Fig.2 #6 (Col. 2, line 6-10)) for the purpose of reinforcement and increase the compression strength of sleeve. It would have been an obvious to one having ordinary

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skill in the art at the time the invention was made to have provide a longitudinally extending strips in Lohbeck in order to reinforcement and increase the compression strength of sleeve as taught by Akeyson.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam Caothulen whose telephone number is (703) 308-8591. The examiner can normally be reached on M-F (8:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bethanne Dayoan can be reached on (703) 308-3865. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 305-3598 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Nam Caothulen
Examiner
Art Unit 3627

NC
July 2, 2001

**B. DAYOAN
SUPERVISORY PATENT EXAMINER
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